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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,923	05/30/2001	Chikara Murata	108421-00016	5150

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EXAMINER
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CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/866,923

Applicant(s)

MURATA, CHIKARA

Examiner

Victor S. Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 6, 8, 10 and 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 6/7/2005. Applicants' amendment to claim 1 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Election/Restrictions***

4. Upon a review of previous restriction/election requirement, it is noted that since amended claim 2, other than a recitation of an un-elected element "anti-static function" (see reply dated 9/9/2002), fails to further limit independent claim 1, as such claim 2 is also withdrawn as non-elected, so as its dependent claims 4, 8, 10 and 12.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, 7 and 9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, it is noted that claim 1 has been amended to recite *inter alia* "wherein the predetermined color of said anti-reflection layer is different from the predetermined color of said adhesive layer." However, Applicant fails to point out any express or inherent support in the specification, as such the amendment appears to be new matter. Applicant is required to either point out the support in the specification, or cancel new matter in the next reply.

#### ***Rejections Based on Prior Art***

7. Claims 1, 5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schroeder et al. (US 5820957) in view of Nishizawa et al. (US 6268704), and further in view of Miyashita et al. (US 5759643) and JP 2000265133 A (Abstract), generally as set forth in section 3 of Office action dated 3/10/2005, together with the following additional reasoning and response to argument.

First, for the purpose of clarification, the Examiner repeats the relied upon prior art as follows: Schroeder's invention is related to an anti-reflective film. Schroeder teaches that the film construction contains a transparent polymeric support film disposed between an anti-reflective polymeric film and a transparent adhesive (column 1, line 66 to column 3, line 6). Further, any of the many known optically transparent adhesives are suitable, including acrylate pressure sensitive adhesives formed from monomers of various acrylate monomers and acrylic acid, etc. (column 5, lines 39-67).

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It should be noted that acrylic acid inherently comprises a carboxyl and/or hydroxyl group. Schroeder lacks a teaching of an anti-reflection layer being formed by resin in which low reflective index material disperses therein. However, Miyashita's invention is directed to an optical device comprising an anti-reflection layer, and Miyashita expressly teaches that an "anti-reflection layer may have a monolayered structure comprising a layer of ultra-low refractive index, or a multilayered structure ... Alternatively, the anti-reflection layer may also be formed by using particular resins ... For example, the layer of ultra-low refractive index may be produced by using an acrylic resin having a fluorine-containing substituent introduced therein" (column 7, lines 17-31). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to substitute Schroeder's anti-reflection layer with an alternative anti-reflection layer, as taught by Miyashita. As to the complementary color in the adhesive layer, it is noted that Nishizawa's invention is directed to a coating of a complementary coloring matter for a cathode ray tube, so as to render the body color of the cathode ray tube achromatic (column 3, lines 41-52). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to incorporate a color matter in the adhesive layer, so as to be complementary to color hue of the anti-reflective film, as taught by Nishizawa, motivated by the desire to obtain an anti-reflective adhesive film which is achromatic or colorless for viewing comfort. Finally, regarding a colorant comprising carbon black in the adhesive layer, it is noted that the invention of JP '133 is directed to an anti-reflection film which comprises a transparent substrate, an adhesive layer on one side of the substrate, and an anti-reflection layer on the other side of the

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substrate (Abstract). JP '133 expressly teaches that it is conventional to include coloring agents, such as carbon black, in a display device for adjusting the amount of transmitted light (paragraph 0002). Further, JP '133 expressly teaches that the anti-reflection film for neutral gray (i.e., achromatic) electronic displays is characterized by including carbon black in the adhesive layer (paragraph 0004). As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to modify the anti-reflection film to also include carbon black in the adhesive layer, as taught by JP '133, motivated by the desire to improve the anti-reflection film by adjusting the required amount of transmitted light.

Referring to newly added limitation in claim 1, which appears to be a new matter as set forth above, Applicant's argument "Schroeder discloses ... an anti-reflective layer formed by forming a roughened surface ... the presently claimed invention in which inorganic low refractive index material, etc., is dispersed in resin. Thus, Schroeder et al. does not teach or suggest the anti-reflection layer of the presently claimed invention ... Schroeder et al. also does not teach or suggest that the anti-reflection layer and the adhesive layer each have a different predetermined color to render the adhesive film achromatic" (Remarks, pages 6-7) has been carefully considered, but is not persuasive. First, Applicant clearly argues the Schroeder reference individually, and the Examiner respectfully reminds Applicant that for the reflective layer the grounds of rejection are based on the combined teachings of Schroeder in view of Miyashita et al., as set forth above. Applicants' argument is without merit to the present rejection. Second, while Miyashita is silent about the color hue of its reflective layer, since Miyashita teaches a

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reflective layer having the same composition as the instantly claimed invention, in the absence of evidence to the contrary, it is the Examiner's position that its color hue is also inherently the same. It should be noted that mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP § 2145.II.

Similarly, with respect to Applicant's argument "Nishzawa et al. also does not teach or suggest that the anti-reflection layer of the presently claimed invention in which inorganic low refractive index material, etc., is dispersed in resin ... also does not teach or suggest that the ant-reflection layer and the ... adhesive layer each have a different predetermined color to render the adhesive film achromatic as required by claim 1" (Remarks, page 7, second full paragraph), the Examiner notes again that Applicant clearly argues the Nishzawa reference individually, and also fails to recognize that Miyashita's teaching of anti-reflection layer being relied upon, as set forth above. Applicants' argument is without merit to the present rejection.

Finally, with respect to Applicant's argument "JP '133 merely discloses carbon black dispersed in the adhesive layer in order to adjust light transmittance and light scattering ratio of an image displaying part, and not to color the adhesive layer. Therefore, component and effects of the adhesive film for a display according to the present invention are different ..." (Remarks, page 9), the Examiner notes that JP '133 reads on the instant invention as claimed, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art

cannot be the basis for patentability when the differences would otherwise be obvious.  
See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

### **Conclusion**

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*

Victor S Chang  
Examiner  
Art Unit 1771

7/12/2005

  
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